UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/887,781	06/22/2001	Carol Ann	END920000180US1	8707

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EXAMINER
NGUYEN, TAN D

ART UNIT	PAPER NUMBER
3689	

NOTIFICATION DATE	DELIVERY MODE
12/30/2009	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ojanenpatentlaw@charter.net

	Application No.	Applicant(s)
Office Action Summary	09/887,781	ANN ET AL.
	Examiner	**Art Unit**	
	Tan Dean D. Nguyen	3689	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on *04 November 2009*.

2a) ☐ This action is **FINAL**.   2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *1,2,4,6,9,10,13-23,26,27,29 and 30* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) *1,2,4,6,9,10,13-23,26,27,29 and 30* is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☒ The drawing(s) filed on *22 June 2001* is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a) ☐ All   b) ☐ Some * c) ☐ None of:

      1. ☐ Certified copies of the priority documents have been received.

      2. ☐ Certified copies of the priority documents have been received in Application No. _____.

      3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1.   A request for continued examination under 37 CFR 1.114, including the fee set

forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this

application is eligible for continued examination under 37 CFR 1.114, and the fee set

forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action

has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 8/31/09

has been entered.

I.   Response to Amendment

2.   The amendment of 8/31/09 has been entered.

II.   Claim Status

3.   Claims 1-2, 4, 6, 9-10, 13-23, 26-27, and 29-30 are pending. Claim 3, 5, 7-8, 11-

12, 20, 24-25 and 28 have been canceled. The pending claims comprise 3 groups:

        1) system[1]: 1-2, 4, 6, 18-19, 21-23, 26-27 and 29,

        2) method: 9-10, 13-17, and

        3) system[2]: 30.

        Claim 3, 5, 7-8, 11-12, 20, 24-25 and 28 have been canceled.

        As of 8/31/09, Claim 1 is as followed:

1. (Currently Amended) A computer system to model a business enterprise and its

information technology, comprising:

        a) at least one computer processing unit;

b) at least one memory connected to at least one computer processing unit;

c) an integrated enterprise component representing the business enterprise and comprising a business component integrated and operationally linked with an information technology component, the components stored in at least one computer memory and ~~accessible by~~ executable in at least one computer processing unit;

c_1) the business component further comprising a plurality of business section components operationally integrated ~~providing one or more relationships~~ with at least one other business section component;

d) the information technology component further comprising:

d_1) at least one application software component ~~processing~~ to process at least business information data from the business component, and

d_2) a plurality of information technology section components operationally integrated providing ~~one or more relationships~~ with at least one other information technology section component;

e) a guiding component ~~accessible to a user for guiding the user~~ user interface to access and change one or more of the section components;

f) an assessment component ~~that determines~~ to assess how a change in one section component effects the relationships with others of the section components; and

g) an impact assessment work product generated by ~~at least one computer~~ ~~processing~~ unit generator component to generate a work product that outputs the results of the assessment component.

Claim Rejections - 35 USC § 112

4.   **Claims** 1-2, 4, 6, 18-19, 21-23, 26-27 and 29 (apparatus), are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

1) *Claim* 1 is vague and indefinite since the claims uses "method steps" such as ""effects the relationship", "that outputs", etc. in an apparatus claims. See IPXL Holdings. Va. Amazon.com (Fed. Circuit 2005). System claim that includes a method step is invalid as indefinite since it's not clear what is the scope of the apparatus claim.

Note: In examination of the apparatus claim, the claims must be structurally distinguishable from the prior art. While features of an apparatus claim may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. See (1) MPEP 2114. (2) *In re Schreiber, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997)*. Apparatus claims cover what a device is, not what a device does, i.e. "device which acts or performs ...". (3) *Hewlett-Packard Co. vs. Bausch & Lomb Inc. (Fed. Circ. 1990).* Manner of operating the device or elements of the device, i.e. recitation with respect to the manner in which a claimed apparatus is intended to be employed/used, does not

differentiate apparatus from the prior art apparatus. (4) *Ex parte Masham,* 2 USPQ2d

1647 (BPAI, 1987).

5.   **Claims 1-2, 4, 6, 18-19, 21-23, 26-27, 29 (system), 9-10, 13-17 (method), and**

30 (system) are rejected under 35 U.S.C. 103(a) as being unpatentable over

MYRICK ET AL in view of HUANG et al (US 6,151,582).

As for independent claim 1 and 9, MYRICK ET AL discloses a computer

system to model a business enterprise and its information technology, comprising:

a) at least one computer processing unit;

b) at least one memory connected to at least one computer processing unit;

c) an integrated enterprise component representing the business enterprise and

comprising a business component integrated and operationally linked with an

information technology component, the components stored in at least one computer

memory and ~~accessible by~~ executable in at least one computer processing unit;

c_1) the business component further comprising a plurality of business section

components operationally integrated ~~providing one or more relationships~~ with at least

one other business section component;

d) the information technology component further comprising:

d_1) at least one application software component processing to process at

least business information data from the business component, and

d₂) a plurality of information technology section components operationally

integrated providing ~~one or more relationships~~ with at least one other information

technology section component;

e) a guiding component user interface to access and change one or more of the

section components;

f) an assessment component, and

g) an impact assessment work product.

See Figs. 1, 2, 11, 20, 2127, 29, 30, 31A, 31B, 32, 35, 38A, 39, 42A and 42B,

especially 43 and 44A-44B, see abstract "impacts", cols. 1-2, "assessing an enterprise

architecture", "model", cols. 3-4 "current state to a new way of conducting business",

and 9 "workflow scenarios", col. 10, lines 5-65.

MYRICK ET AL fairly teaches the claimed invention except for further details on

elements (e) and (f) and (g).

In a similar computer system to model a business enterprise and its business

application, HUANG ET AL fairly teaches a decision support system for modeling

business trend, business scenarios and determining impacts of the scenarios,

comprising:

e) a guiding component user interface to access and change one or more of the

section components;

f) an assessment component to assess how a change in one section component

effects the relationships with others of the section components; and

g) an impact assessment work product generated by unit generator component

to generate a work product that outputs the results of the assessment component.

Note: independent claim 1 is (appears to be) an apparatus claim. In examination

of the apparatus claim, the claims must be structurally distinguishable from the prior art.

While features of an apparatus claim may be recited either structurally or functionally,

claims directed to an apparatus must be distinguished from the prior art in terms of

structure rather than function. See (1) MPEP 2114. (2) *In re Schreiber, 128 F.3d 1473,*

1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997). Apparatus claims cover what a

device is, not what a device does, i.e. "device which acts or performs ...". (3) *Hewlett-*

Packard Co. vs. Bausch & Lomb Inc. (Fed. Circ. 1990). Manner of operating the device

or elements of the device, i.e. recitation with respect to the manner in which a claimed

apparatus is intended to be employed/used, does not differentiate apparatus from the

prior art apparatus. (4) *Ex parte Masham*, 2 USPQ2d 1647 (BPAI, 1987).

Also, this is an apparatus claim and intended use limitation for the system/device

or apparatus, i.e. "***to model*** …technology" in the preamble carries no patentable weight.

Similarly, in the body of the claim, the phrase "to process" or "to access", etc., are

considered as "intended use".

It is first important to note that the use of the term "component" leaves open to

interpretation whether "component" is a device or a software component. *See In re*

Comiskey, 499 F.3d 1365, at 1379 (Fed. Cir. 2007). Since the "components" being

stored in at least one computer memory, this indicates that the "components" are

software components.

However, current claim 1 only describes each of the different component using

functional language, i.e.,

"an integrated interprise component representing the business enterprise...",

" a guiding component user interface to access and change ...",

"an assessment component to assess..." and

"an impact assessment work product generator component to generate a work

product that outputs...",

without tying such descriptions to positive claim language, such as produced

when one uses the term "configured" or, even more positively, 35 U.S.C. 112, sixth

paragraph language. Unlike the machine claim in Prater which used means

plus function language to describe its device, see Prater at 1397-1398,

Current claim 1 does not use such language, and thus should not be

given the same interpretation of the machine claim in Prater. To do so

would be to dilute the provisions of the statute. However, although

Appellants' language is functional, we are nevertheless required to give the

language weight to the extent that the prior art is or is not capable of meeting

the functional limitation. See In re Schreiber, 128 F.3d 1473 (Fed. Cir.

1997).   Note that the last element uses a step "that outputs" that is not even an

apparatus element or structure.

Also, this is an apparatus claim and <u>intended use</u> limitation for the system/device or apparatus, i.e. "to model ...technology" in the preamble carries <u>no</u> patentable weight.

It is first important to note that the use of the term "component" leaves open to interpretation whether "component" is a device or a software component. *See In re Comiskey,* 499 F.3d 1365, at 1379 (Fed. Cir. 2007). Since the "components" being stored in at least one computer memory, this indicates that the "components" are software <u>components</u>.

However, current <u>claim 1</u> only describes each of the different component using functional language, i.e.,

"an integrated interprise component representing the business enterprise...",

" a guiding component accessible to a user for guiding the user to access and change ...",

"component that determines.." and

"an impact assessment work product generated by at least... that outputs the results",

without tying such descriptions to <u>positive</u> claim language, such as produced when one uses the term "<u>configured</u>" or, even more positively, 35 U.S.C. 112, <u>sixth paragraph language</u>. Unlike the machine claim in *Prater* which used means plus function language to describe its device, *see Prater* at 1397-1398, Current <u>claim 1</u> does not use such language, and thus should not be given the same interpretation of the machine claim in *Prater.* To do so would be to dilute the provisions of the statute. However, although

Appellants' language is functional, we are nevertheless required to give the

language weight to the extent that the prior art is or is not capable of meeting

the functional limitation. *See In re Schreiber,* 128 F.3d 1473 (Fed. Cir.

1997).   Note that the last element "an impact assessment work product" is not even an

apparatus element or structure.

As for independent system claim 1, similarly, HUANG et al discloses an

enterprise system for modeling the operation of a business enterprise and determining

the impact how a change in one section component effects the entire (whole) business

system or the relationships with others of the sections components, the system

comprising:

A computer system to model a business enterprise and its information

technology, comprising:

a) at least one computer processing unit;

b) at least one memory connected to at least one computer processing unit;

c) an integrated enterprise component representing the business enterprise and

comprising a business component integrated and operationally linked with a business

sub component, the components stored in at least one computer memory and

accessible by at least one computer processing unit;

d) the business component further comprising a plurality of business section

operationally integrated providing one or more relationships with at least one other

business section component;

d) the business sub component further comprising at least one application

software component processing at least business information data from the business

component, and a plurality of business section sub components operationally integrated

providing one or more relationships with at least one other business sub-section

component;

e) a guiding component accessible to a user for guiding the user to access and

change one or more of the section components;

f) an assessment tool component that determines how a change in

one section component effects the relationships with others of the section components;

and

g) an impact assessment work product generated by at least one computer

processing unit that outputs the results of the assessment component.

{see Figs. 1, 2, 4, 34, 35, 37, especially **41**, and cols. 1-2, 91-92, "...*dynamically*

monitors the impact *of the user's decisions on* *the performance of the entire supply*

chain *by using supply chain* *simulation*", cols. 106-107 and 111-112.}

HUANG et al fairly teaches the claimed invention except for the difference in the

business sub-component, i.e. an information technology (IT) component (architecture).

Therefore, it would have been obvious to a person having ordinary skill in the art

(herein after as "PHOSITA") at the time of the invention was made to modify the type of

sub-business component system and method of HUANG et al to (IT) component as

taught by MYRICK ET AL, as mere using other well known sub-business component

that current have the same issues that requires an answer as taught in HUANG et al for

determining impacts/effects of various business scenarios or decisions as a whole both

currently and into the near future that <u>support managers in making decisions</u> {see col. 1,

lines 35-42, Figs. 65-67}, since so doing could be performed readily and easily by any

person of ordinary skill in the art, with neither undue experimentation, nor risk of

unexpected results.

6.   Following KSR, the Supreme Court issued several rationales for supporting a

conclusion that a claim would have been obvious. If a particular known technique was

recognized as part of the ordinary capabilities of one skilled in the art, and one of

ordinary skill in the art would have been capable of applying this known technique to a

known device (method, or product) and the results would have been predictable to one

of ordinary skill in the art; then the claim will be deemed obvious in view of the prior art.

        As for dep. claims 2, 4 (part of <u>9</u> above) which deal with an element/item for

accessing the data for changing/modifying business element, this is taught in HUANG et

al /AAPA as shown in HUANG et al Figs. . 1, 2, 4, 34, 35, 37, especially **41**, and cols. 1-

2, 91-92, "…*dynamically **monitors the impact** of the user's decisions on **the***

***performance of the entire supply chain** by using supply chain **simulation**"*, cols. 106-

107 and 111-112.}

        As for dep. claims 6, 18-23, 26-27, 29, which deal with architecture (organization

structures) parameters for the business enterprise and the information technology,

these are fairly taught in Figs. 1, 2 of MYRICK ET AL and HUANG et al Figs. 2, -4, 7, 9.

34-35, 41 and cols. 1-2 and 91-92. Moreover, these terms or structures appear to be non-functional in a data processing system.

As for independent claims 9 and system claim 30, which appear to be the method claim and system claim to carry out the independent article claim 1 above, they are rejected over the article/computer program product claim of HUANG et al / AAPA as shown on Figs. 1-2, and 41 of HUANG et al. .

As for dep. claims 10 and 13-17 (part of 9 above), which appear to have the same limitations as in dep. claims 2, 4, 6, 18-23 and 26 (part of 1 above), they are rejected for the same reasons set forth above.

Response to Arguments

7.   Applicant's arguments with respect to the previous rejections on 8/31/09 have been considered but are moot in view of the new ground(s) of rejection which are due to applicant's amendment.

8.   In response to applicant's argument that HUANG ET AL is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, the specific business application in HUANG ET AL, supply chain management, is not essential to the scope of the claim which is modeling business decision and determining impacts as shown in cols. 1-2 and Figs. 7 and the use of

teachings of HUANG ET AL for other business issue such as IT components as taught

in MYRICK ET AL is within the skill of the artisan.

    No claims are allowed.

9.   Information regarding the status of an application may be obtained from the
Patent Application Information Retrieval (PAIR) system. Status information for
published applications may be obtained from either Private PAIR or Public PAIR.
Status information for unpublished applications is available through private PAIR only.
For more information about the PAIR system, see http://pair-direct@uspto.gov. Should
you have any questions on access to the private PAIR system, contact the Electronic
Business Center (EBC) at 866-217-9197 (toll free).

        For more information about the PAIR system, see
http://portal.uspto.gov/external/portal/pair. Should you have questions on access to the Private
PAIR system, contact the Electronic Business Center (EBC) at **866.217.9197** (toll-free).
1.   Any response to this action should be mailed to:
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                Hand delivered responses should be brought to the
                US Patent and Trademark Office Customer Service Window:
                Randolph Building
                401 Dulany Street
                Alexandria, VA 22314.

2.   In receiving an Office Action, it becomes apparent that certain documents are
missing, e. g. copies of references, Forms PTO 1449, PTO-892, etc., requests for
copies should be directed to Tech Center 3600 Customer Service at (571) 272-3600, or
e-mail CustomerService3600@uspto.gov .

3.   Any inquiry concerning the merits of the examination of the application should be
directed to Dean Tan Nguyen at telephone number (571) 272-6806. My work schedule
is normally Monday through Friday from 6:30 am - 4:00 pm. I am scheduled to be off
every other Friday.   Should I be unavailable during my normal working hours, my
supervisor Janice Mooneyham can be reached at (571) 272-6805. The main FAX
phone numbers for formal communications concerning this application are **(571) 273-
8300**. My personal Fax is (571) 273-6806. Informal communications may be made,
following a telephone call to the examiner, by an informal FAX number to be given.

/Tan Dean D. Nguyen/
Primary Examiner, Art Unit 3689
12/18/09